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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,734	08/04/2003	Eric A. Lindholm	119.0016	3269

7590 01/25/2005

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EXAMINER

EDWARDS, LAURA ESTELLE

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/633,734

Applicant(s)

LINDHOLM, ERIC A.

Examiner

Laura Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 9-14 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 8 and 15 is/are rejected.
- 7) ☒ Claim(s) 4, 6, 7, 16 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8 and 15-17, drawn to a fiber coating apparatus or applicator, classified in class 118, subclass 407.
- II. Claims 9-14, drawn to a fluid supply system for a fiber coating apparatus or applicator, classified in class 118, subclass 712.
- III. Claims 18-20, drawn to a method of coating, classified in class 427, subclass 162.

The inventions are distinct, each from the other because of the following reasons:

Inventions III and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used for a materially different process such as impregnating textiles.

Inventions II and I are deemed independent and distinct inventions in that the invention of Group I does not require a pump as required by the invention of Group II and the invention of Group I can be supplied with coating material other than via the use of a pump such as by way of pressurized air or a chemical reaction due to mixing of coating reagents.

Inventions III and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice

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another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used for a materially different process such as lubricating wire.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Kim on 11/29/04 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8 and 15-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-14 and 18-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Paek et al (US 4,539,226).

Paek et al teach a fiber coating applicator comprising a chamber (16), a cup (14) positioned over the chamber, the cup connected to the chamber by an entrance aperture (not

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numbered), the chamber including an exit aperture (22) opposite the entrance aperture, the cup, entrance aperture, chamber, and exit aperture defining a pathway for a fiber to be coated, the chamber further including an input port for pumping a coating material into the chamber, the entrance aperture being dimensioned such that as a fiber travels along the pathway and coating material is pumped into the chamber, coating material travels upward through the entrance aperture around the fiber into the cup, the upward flow of coating material (see claim 1, lines 40-45) being restricted by the fiber and entrance aperture such that there is a pressure above ambient atmosphere in the chamber, the exit aperture being dimensioned to shape coating material around a fiber traveling along the pathway.

With respect to claim 2, see drain (52).

With respect to claim 3, see entrance die assembly (12).

With respect to claim 15, see the rejection above.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paek et al (US 4,539,226).

The teachings of Paek et al have been mentioned above but Paek et al does not teach or suggest a shaping die assembly mounted in the chamber. However, because Paek et al recognizes at least a shaping die (22) at the exit aperture or snout of the chamber (16), it would have been within the purview of one skilled in the art to provide a shaping die within or outside of the chamber in so long as the coating fiber is shaped following coating.

With respect to claim 8, even though the entrance aperture and exit aperture dimensions are not disclosed by Paek et al, it would have been obvious to one of ordinary skill in the art to provide die entrance and exits of appropriate dimensions to provide for a coated optical product with desired coating thickness. Setting the dimensions of the entrance and exit aperture for a desired product with an appropriate coating thickness would be determined via routine experimentation. Applicant's remaining claimed coating operating parameters such as coating viscosity, thickness, etc. have been given no patentable weight these are process limitations and not structural limitations.

#### *Allowable Subject Matter*

Claims 4, 6, 7, 16, and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Edwards whose telephone number is (571) 272-1227. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Laura Edwards  
Primary Examiner  
Art Unit 1734

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January 24, 2005